

REMARKS

Prior to the present amendment, claims 1-63 were pending. In order to expedite and focus prosecution, Applicant has canceled claims 26-53 and 58-63 without prejudice and reserves the right to pursue such claims at a later time. Reconsideration of claims 1-26 and 54-57 in light of the following is earnestly requested.

Claim Objections

The Office Action objected to claims 1-63 due to Listing of Claims in the Preliminary Amendment not beginning on a separate page. The Listing of Claims in the present Amendment begin on a separate sheet. Withdrawal of the present objection is respectfully requested.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

The Office Action rejected claim 53 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter which the Applicant regards as the invention. Claim 53 has been canceled thus rendering the present rejection moot.

Claim Rejections Under 35 U.S.C. §103 (Schneider)

The Office Action rejected claims 1-9, 13-15, and 18-22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pub. 2003/00787101 (Schneider). Applicant requests the present rejection be withdrawn in light of the following.

Claims 1-9

Each of claims 1-9 is directed to a gaming system comprising a plurality of gaming machines, wherein each said gaming machine includes a game selector, which displays a selection of games available on that gaming machine for a player to play and wherein the

selection is determined dependent on the player's past history of playing games and a history of games played by other players. Applicant respectfully submits that Schneider neither discloses or otherwise renders obvious a gaming system comprising a plurality of gaming machines with the above features.

On page 4, the Office Action states that a "multiple games screen option on a game machine is well known in the art." However, the Office Action provides no evidence in support of this conclusory statement was in fact the case at the priority date of the present application. Applicant is unaware of game machines having such a feature at the priority date of the present application. Surely if such a game screen option was well known as the Office Action contends, the Examiner should be able to produce at least one published piece of prior art to support the assertion without undue burden. The Applicant respectfully requests the Examiner to produce such a reference so that the Applicant may better assess the appropriateness of the present rejection.

In regard to the selection of games being determined dependent on the player's past history of playing games, the Office Action on page 4 appears to cite paragraphs [0038] and [0056] of Schneider for a teaching of such concepts. Applicant respectfully submits that Schneider does not appear to disclose such features of claims 1-9 in paragraph [0038], paragraph [0056], or elsewhere. Paragraph [0038] discusses tailoring a gaming experience for a player based upon information collected about the player. Paragraph [0052] discusses monitoring gameplay and other conditions to determine when triggering events have been met, and generating game enhancing rewards for a player once such triggering events have been met. Paragraphs [0038] and [0056] do not address selecting games dependent upon a player's past

history, but instead upon customizing a game for a player which is in fact the focus of the Schneider patent application.

Applicant respectfully points out that Schneider does not address how a selection of games is presented to a player via a gaming machine that supports multiple games, but instead addresses how a gaming experience may be customized for a player. Schneider identifies several ways a gaming experience may be customized for a player. For example, Schneider mentions changing the award amounts for specific events (paragraph [0061]); offering awards for multiple events (paragraph [0062]); changing the outcome probabilities (paragraph [0063]); changing the rules of play (paragraph [0081]); offering casino environmental related prizes (paragraph [0083]); and various other manners (See, paragraphs [0084]-[0097]).

While Schneider discloses various ways of tailoring a gaming experience to a player, none of the manners disclosed by Schneider are directed to presenting a selection of games to a player that is determined from the player's past history of playing games and a history of games played by other player. Schneider in fact appears to provide almost no teaching regarding a gaming machine for playing multiple games. As noted by the Examiner, Schneider FIG. 2 depicts a gaming machine 20 having a "Change Game" control button 84. However, Schneider paragraph [0021] appears to be the only paragraph that references the control buttons 84 of the gaming machine 20. Of note, while paragraph [0021] mentions the "Bet", "Max Bet", and "Spin" control buttons, Schneider makes no specific reference to the "Change Game" control button 84 depicted in FIG. 2. As such, one is left to merely speculate as to how the gaming machine 20 reacts to the actuation of the "Change Game" control button or how the "change game" feature of the gaming machine 20 is implemented. Applicant respectfully submits that the reason for this almost non-existent disclosure is that Schneider simply does not teach a manner

for providing a player with a selection of games. Schneider instead addresses how to customize a selected game for a player in order to enhance the gaming experience of the player.

Accordingly, Schneider fails to arrive at the invention of claims 1-9.

On page 4, the Office Action notes that Schneider does not teach that the game selection is based upon the history of games played by others. However, the Office Action appears to be taking the position that Schneider teaches a gaming machine that presents game selections based upon the history of games played by the player. As noted above, Schneider does not provide such a teaching. Schneider merely teaches ways of customizing a game for a player, but does not disclose a manner by which the selection of games presented to a player is determined from the player's history and the history of others. Moreover, given Schneider is not addressing the problem of how to present a selection of games to a player, there seems to no reason why one skilled in the art would consider claims 1-9 obvious in light of Schneider.

Since Schneider fails to teach or otherwise render obvious a gaming system having a gaming machines that present a selection of available games determined dependent upon the player's past history of playing games and a history of games played by other players, the Office Action has failed to establish a *prima facie* case of obviousness in regard to claims 1-9.

Withdrawal of the present rejection of claims 1-9 is earnestly solicited.

Claims 13-15 and 18-22

Each of claims 13-15 and 18-22 include a game selector which displays a selection of games available on a gaming machine, the selection being determined dependent on the player's past history of playing games and a history of games played by other players. As noted above, in regard to claims 1-9, Schneider does not teach a manner of presenting a selection of games to a player nor does Schneider otherwise render obvious a game selector that displays a selection

determined dependent on the player's past history of playing games and a history of games played by other players. As such, the Office Action has failed to establish a prima facie case of obviousness in regard to the claims 13-15 and 18-22. Applicant requests the rejection of claims 13-15 and 18-22 be withdrawn.

Claim Rejections Under 35 U.S.C. §103 (Schneider/Paulsen)

The Office Action rejected claims 10-12, 16-17, 23-41, and 43-63 under 35 U.S.C. §103(a) as being unpatentable over Schneider in view of U.S. Pub. 2002/0142846 (Paulsen). Claims 26-41 and 43-63 have been canceled. Applicant requests the present rejection of the pending claims be withdrawn in light of the following.

Claims 10-12, 16-17, and 23-25

Each of claims 10-12, 16-17, and 23-25 includes at least one of claims 1 and 18 as a base. Accordingly, each of claims 10-12, 16-17, and 23-25 is allowable for at least the reasons mentioned above in regard to their respective base claims. Withdrawal of the present rejection of claims 10-12, 16-17, and 23-25 is earnestly solicited.

Claims 55-57

Each of claims 55-57 include claim 1 as a base claim and is therefore allowable for at least the reasons mentioned above in regard to claim 1.

In regard to claim 55 and 57, Applicant notes while games could be ranked based on win/loss records, Schneider does not in fact disclose ranking games on win/loss records. Schneider merely discloses tailoring a gaming experience based upon a player having a "dry spell". Moreover, such rankings still would not be "allocated to a game by a player" as required by claim 55.

In regard to claim 56, Applicant notes the selection of games is determined dependent on the age of the games not the age of the players as indicated by the Examiner.

Withdrawal of the present rejection of claims 55-57 is earnestly requested.

Final Matters

The Office Action includes various statements regarding the pending claims; Schneider and Paulsen; 35 U.S.C. §112 and 35 U.S.C. §103; and one of skill in the art that are now moot in view of the previous amendments and/or arguments. Thus, the Applicant has not addressed all of such moot statements at the present time. The Applicant, however, expressly reserves the right to challenge or support any or all of such statements in the future should the need arise (e.g., should such statements become relevant in the future by appearing in a rejection of any claim or appearing in any legal proceeding).

CONCLUSION

The Applicant submits that the pending claims are in condition for allowance and courteously solicits an expeditious Notice of Allowability with respect to all pending claims. If the Examiner disagrees or has questions regarding this submission, the Applicant respectfully requests that the Examiner telephone the undersigned at 312-238-8600 to discuss the present pending claims and the references, in particular prior to issuing a final action on the merits.

The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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/Jeffrey B. Huter/

Jeffrey B. Huter
Reg. No. 41,086

McAndrews, Held & Malloy, Ltd.
500 W. Madison Street, 34th Floor
Chicago, IL 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100